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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,223	08/28/2003	Chiyumi Niwa	B422-241	6354
26272 7590 06/15/2007 COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER LAM, HUNG H	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 06/15/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/650,223	Applicant(s) NIWA, CHIYUMI	
	Examiner Hung H. Lam	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Regarding **claim 10**, the claimed invention is directed to non-statutory subject matter. Simply, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “thing.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. See MPEP 2106.IV.B.1.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kudo (US-2005/0,225,652).

With regarding **claim 1**, Kudo discloses an image pickup apparatus including a first mode for picking up an object image and a second mode for reproducing a recorded image, said apparatus comprising:

an operation member which is switched to said first mode according to an operation to a first position (Fig. 3; see dial 206 and camera position), and is switched to said second mode according to an operation to a second position (Fig. 3; see dial 206 and playback position), and further is suppressed to a third position during a period of time except for the operations (Fig. 3; see dial 206 and off position; 0051-0053); and

control means (Fig. 1; micro computer 107) for changing control to said image pickup apparatus both according to a current mode and according to a position to which said operation member is operated (0057-0063).

With regarding **claim 3**, Kudo discloses an image pickup apparatus wherein in case that said image pickup apparatus is in an electric power off state (see Fig. 3; dial 206 and the off position), said control means turns electric power on according to a mode switching operation of said operation member and starts up said image pickup apparatus in a mode corresponding to a position operated in the mode switching operation (0051-0053).

With regarding **claim 7**, Kudo discloses an image pickup apparatus including a first mode for picking up an object image and a second mode for reproducing a recorded image, said apparatus comprising:

an operation member which is switched to said first mode according to an operation to a first position (Fig. 3; see dial 206 and camera position), and is switched to said second mode according to an operation to a second position (Fig. 3; see dial 206 and playback position), and further is suppressed to a third position during a period of time except for the operations (Fig. 3; see dial 206 and off position; 0051-0053); and

control means (Fig. 1; micro computer 107) for turning electric power of said image pickup apparatus on and determines an operating mode according to a position to which said operation member is operated (0057-0063), when said operation member is operated in a state in which the electric power of said image pickup apparatus is off operations (Fig. 3; see dial 206 and off position; 0051-0053).

With regarding **claim 8**, the claim is a method claim of the apparatus claim 1. Therefore, claim 8 is analyzed and rejected as previously discussed in claim 1.

With regarding **claim 9**, the claim is a method claim of the apparatus claim 7. Therefore, claim 9 is analyzed and rejected as previously discussed in claim 7.

With regarding **claim 10**, Kudo discloses a storage medium (0057) comprising a stored program for executing said control method of an image pickup apparatus according to claim 8 (see the rejection of claim 8 and/or 1).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo.

With regarding **claim 5**, Kudo fails to explicitly disclose an image pickup apparatus wherein in a state of said first mode, said control means switches to a mode different in photographing format from that of said first mode according to the operation of said operation member to said first position.

Official Notice is taken that it is well known and expected in the art for an image pickup apparatus to be switched to different photographing format such that one of the wide angle,

telephoto angle, landscape and portrait format. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Kudo to switch to different photographing format. The modifications thus provide a more versatile camera.

With regarding **claim 6**, Kudo fails to explicitly an image pickup apparatus according to claim 1, wherein position in a state of said second mode, said control means switches to a mode different in reproduction format from that of said second mode according to the operation of said operation member to said second position.

Official Notice is taken that it is well known and expected in the art for an image pickup apparatus to be switched to different reproduction format such that one of the quick review and slide slow. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Kudo to switch to different reproduction format. The modifications thus provide a more versatile camera.

8. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo in view of Ejima (US-2002/0,008,765).

Regarding **claim 2**, Kudo fails to explicitly disclose an image pickup apparatus according to claim 1, wherein during said second mode, said control means shifts said second mode to said first mode without operating said operation member, and according to an operation of other operation member related to photographing.

In the same field of endeavor, Ejima teaches a camera which performs a photographing operation immediately by operating a shutter release button (5) even in the quick review mode.

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(0095-0096). In light of the teaching from Ejima, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Kudo to perform a photographing operation even in the quick review mode. The modifications thus allow a digital camera to capture any desired images at any instances.

With regarding **claim 4**, Kudo fails to explicitly disclose an image pickup apparatus according to claim 1, wherein said control means withdraws a lens barrel according to the operation to said second position by means of said operation member, when said lens barrel is fed forward in a state of said second mode.

In the same field of endeavor, Ejima teaches a camera wherein a photographing zoom lens 2, which has been driven out retracts to the state shown in Fig. 1A if the electronic still camera 1 is switched to the reproduction mode (0038; 0053). In light of the teaching from Ejima, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Kudo to retract a photographing zoom lens in the reproduction mode. The modifications thus provide a means for protecting the photographing zoom lens while images are reviewed.

### *Conclusion*

9. This prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Wakui (US-6,262,767) discloses a camera wherein the release switch is turned on and triggers a reproduction mode to stop.



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b) Kurahashi (US- 7,042,510) discloses a dial switch for dialing a capturing mode, an off mode and a playback mode.

c) Ohnogi (US-2002/0,036,702) discloses a dial switch type for dialing a capturing mode, an off mode and a playback mode.

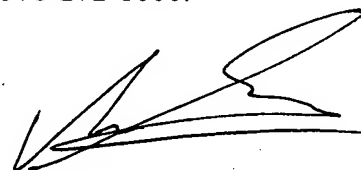
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung H. Lam whose telephone number is 571-272-7367. The examiner can normally be reached on Monday - Friday 8AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SRIVASTAVA VIVEK can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HL

06/09/07



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